

REMARKS

Claims 61-71 and 74-81 constitute the pending claims in the present application. Applicants cancel, without prejudice, claims 63-69 and 74-80. Applicants respectfully request reconsideration in view of the following remarks.

1. Applicants note with appreciation that the previously submitted formal drawings have been approved.
2. Applicants' amendment to the specification and submission of a revised sequence listing are believed to obviate any objections regarding compliance with the sequence rules.
3. Applicants note with appreciation that the previous rejection of claims 62 and 72-75 has been withdrawn. Applicants further note that rejection of claims 61-63, 65, 68, 70, and 74-77 under 35 U.S.C. 102 has been withdrawn in light of Applicants' amendments.
4. Claims 61 and 62 are objected to for the recitation of "affect." Applicants' amendments to the claims to correct this typographical error are believed to obviate the objection. Applicants note that correction of this typographical error does not narrow the scope of the claims.
- 5-6. Claims 63-71 and 74-80 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with both the written description and enablement requirements. Applicants traverse these rejections and contend that the rejections are moot in light of the amended claims.

The basis of these rejections are two fold. First, the Examiner alleges that the specification fails to support claims 63 and 78-80 which are explicitly directed to a particular assay method. Second, the Examiner alleges that claims 74-77 are "reach through" claims intending to capture agents that have not yet been identified. Applicants traverse each of these grounds of rejection.

Applicants have provided extensive evidence indicating that at the time of filing of the present application one of skill in the art could readily envision reporter constructs for use in Applicants' screening methods. Furthermore, in light of the high level of skill in the art and in light of Applicants' disclosure, one of skill in the art could readily make and test various reporter constructs and select reporter constructs for use in the claimed methods. Accordingly,

Applicants maintain that the Examiner's continued reliance on this basis of rejection is inappropriate. Nevertheless, to expedite prosecution, Applicants have cancelled claims 63 and 78-80. Cancellation of these claims is not in acquiescence of the rejection, and Applicants reserve the right to prosecute claims of similar or differing scope.

The second basis of this rejection is that claims 74-77 are allegedly reach through claims that inappropriately intend to capture the agents identified by the subject methods. Applicants contend that this is simply not the case. Claims 74-77 are dependent claims which simply add an additional step to the broad method claims already found allowable by the Examiner. The broad method claims are based on the identification of particular agents. Dependent claims that contemplate formulating such identified agents in pharmaceutically acceptable carriers do nothing to undermine the patentability of these broad method claims. Applicants contrast claims 74-77 to true "reach through" claims intended to capture the agent itself. Clearly, claims 74-77 do not fall into this category of claims. Nevertheless, to expedite prosecution, Applicants have cancelled claims 74-77. Cancellation of these claims is not in acquiescence of the rejection, and Applicants reserve the right to prosecute claims of similar or differing scope. Reconsideration and withdrawal of these rejections are respectfully requested.

7. Claims 74-77 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicants traverse this rejection and contend that the rejection is moot in light of the amended claims.

As outlined in detail above, Applicants contend that the so-called reach through claims do not encompass the particular agents identified by the claimed methods. Instead, claims 74-77 are directed to an additional step whereby the identified agents are formulated in a pharmaceutically acceptable carrier. Accordingly, one of skill in the art can readily appreciate the metes and bounds of the claimed subject matter. Nevertheless, to expedite prosecution of claims directed to commercially relevant subject matter, Applicants have cancelled claims 74-77. Cancellation of these claims is not in acquiescence of the rejection, and Applicants reserve the right to prosecute claims of similar or differing scope. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

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